THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Appellant(s): Carsten Krischker
Appl. No.: 10/517,935
Conf. No.: 6885
Filed: March 9, 2005
Title: METHOD FOR IDENTIFYING A TELECOMMUNICATIONS SUBSCRIBER
Art Unit: 2617
Examiner: Meless Nmn Zewdu
Docket No.: 112740-1043

Commissioner for Patents
P.O. Box 1450
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APPELLANTS' REPLY BRIEF

Sir:

I. INTRODUCTION

Appellants submit Appellants' Reply Brief in response to the Examiner's Answer dated March 29, 2007 pursuant to 37 C.F.R. § 41.41(a). Appellants respectfully submit the Examiner's Answer has failed to remedy the deficiencies with respect to the Final Office Action dated February 14, 2006 as noted in Appellants' Appeal Brief filed on February 28, 2007 for at least the reasons set forth below. Accordingly, Appellants respectfully request that the rejections of pending Claims 22-25, 27, 29-33, 35 and 37-40 be reversed.

II. REGARDING CLAIMS 22, 30, 38 AND 40, A PRIMA FACIE CASE OF OBVIOUSNESS HAS NOT BEEN ESTABLISHED WITH RESPECT TO THE COMBINATION OF *YABLON* AND *ITU-T RECOMMENDATION H.245, SECTIONS 5.2-5.9* (XP-002199601) (HEREAFTER "ITU RECOMMENDATION").

a. *Yablon* and the *ITU Recommendation*, alone or in combination, fail to disclose or suggest all of the recited features of independent claims 22, 30, 38 and 40

The aforementioned independent claims recite a configuration where telecommunication devices transmit data, based on device information that indicates whether or not one of the devices "wants" that information. Specifically,

The method of independent claim 22 recites the step of signaling a call from a second telecommunications device (MFG2) of a second telecommunications subscriber to a first telecommunications device (MFG1) of a first telecommunications subscriber. The first telecommunications device (MFG1) sends device information (FIG. 3; GI1) to the second telecommunications device (MFG2) which indicates a type of subscriber data that the first telecommunication device wants to receive (i.e., the first telecommunication device selectively chooses available options among the subscriber data). Finally, subscriber data is transmitted from the second telecommunications device to the first telecommunications device in accordance with the device information (FIG. 3, UI2; page 15, lines 9-24).

The method of independent claim 30 recites the same features as claim 22, except that the step of sending device information from the first telecommunications device (MFG1) to the second telecommunications device (MFG2) recites that the device information indicates "components of subscriber data" (FIG. 3, TD2) instead of "type of subscriber data" (UI2).

Independent claim 38 recites a telecommunications device (FIG. 1) for identifying a telecommunications subscriber, comprising: a memory (SP, FIG. 2) for storing device information which indicates a type of subscriber data (GI1) that a further telecommunications device (MFG2) wants to receive; a facility (KM) for transferring the device information from the memory to the further telecommunications device (MFG1); and a facility for receiving subscriber data from the further telecommunications device depending on the device information transmitted.

Independent claim 40 recites a telecommunications device (FIG. 1) for identifying a telecommunications subscriber, comprising: a memory (SP) for storing device information which indicates a type of subscriber data (GI1) that a further telecommunications device (MFG2) <u>wants to receive</u>; a facility (KM) for transferring the device information from the memory to the further telecommunications device (MFG 1); and a facility for receiving subscriber data from the further telecommunications device depending on the device information transmitted.

It is apparent to Appellant that the crux of the rejection is based upon the construction of the phrase "data . . . that the [] telecommunication device *wants to receive*." "It is a 'bedrock principle' of patent law that 'the claims of a patent define the invention to which the patentee is entitled to the right to exclude.'" *Phillips v. AWHCorp.*, 415 F.3d 1303, 1312 (Fed. Cir. 2005) (*en banc*). Accordingly, claim construction begins with an analysis of the words of the claim. *Id.; Markman et al. v. Westview Instruments, Inc.*, 52 F.3d 967, 979-80 (Fed. Cir. 1995); *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996). Terms of a claim are generally given their ordinary and customary meaning. <u>Id.</u> This is "the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention" *Phillips*, 415 F.3d at 1313. A person of ordinary skill in the art "is deemed to read the claim term not only in the context of the particular claim in which the disputed term appears, but <u>in the context of the entire patent, including the specification</u>." <u>Id.</u> (emphasis added). The specification "is always highly relevant to the claim construction analysis. Usually, it is dispositive; it is the single best guide to the meaning of a disputed term." <u>Id.</u> For this reason, "[c]laims must be read in view of the specification, of which they are a part." *Markman*, 52 F.3d at 979. "'The construction that stays true to the claim language and most naturally aligns with the patent's description of the invention will be, in the end, the correct construction.'" *Phillips*, 415 F.3d at 1316 (quoting *Renishaw PLC v. Marposs Societa' per Azioni*, 158 F.3d 1243, 1250 (Fed. Cir. 1998)).

In the present case, Appellant respectfully submits that the rejection is taking an excessively literal interpretation of the word "wants," and is improperly formulating a definition that is not consistent with the present disclosure. The Examiner's Answer maintains that the term "wants" is a non-inventive, subjective word, "associated with a human feeling" (page 12, last 2 lines). However, it should be clear that Appellant is not attempting to claim some ethereal desire by a telecommunication device, as though it were a sentient being. As argued previously,

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pending claims must be "given their broadest reasonable interpretation <u>consistent with the specification</u>" (MPEP 2111, emphasis added).

The Examiner's Answer argues that "want" is synonymous with "capability" (see page 13-14). However, this interpretation is contrary to the explicit language in the text of the specification (See FIG. 3 and supporting text), as well as the plain meaning of the word ("something desired, demanded, or required" *Random House Unabridged Dictionary,* © *Random House, Inc.* 2006). The Answer alleges that "'want' is used in the specification as an alternative to the words, 'can' and 'able' (see spec. paragraphs 0008 and 0035)." This position is correct, insofar that a device "wanting" information *is different* (i.e. an alternative mode of operation) from the device being capable to receive the information. In fact, this interpretation supports the Appellant's argument, when read in the context of the specification. The relevant portions of the specification are reproduced below:

> [0008] [T]he term "configured" refers to either the first telecommunications device only having a certain range of features (for example, it can play back or send audio files, but does not have a display suitable for showing image files) <u>or the first telecommunications subscriber having for example, set up his/her telecommunications device so that only certain subscriber data should be received which is indicated to the second telecommunications device using device information.</u> After receiving the first device information, subscriber data is subsequently transmitted from the second telecommunications device to the first in accordance with the first device information. This simply refers to subscriber data transmitted to the first telecommunications device matching the criteria of the first device information and hence represents the subscriber data that the first telecommunications subscriber <u>can or wants</u> to receive.

> [0035] [A]s can be seen in FIG. 3, the device information GI2 contains a version number of the partner, that is the previously transmitted subscriber data for the partner (Recipient E) and a list of optional information which Caller A or his/her telecommunications device <u>can or wants</u> to receive. As such, where Recipient E is <u>able or wants</u> to send the appropriate subscriber data, he/she should transmit all optional subscriber data (reason for calling, title, name, first name, company, function, e-mail address, optional text, image) that is identified by a "1" before the appropriate specific data ("1" means send; "0" means do not send) in accordance with the device information GI2.

[0037] [I]n contrast to the device information GI2, Recipient E has set his/her device information GI1 such that he/she <u>does not want</u> to receive the company, function, e-mail address and optional text from Caller A that is shown by a "0" before the appropriate option.

Here, it is shown that a distinction is made between a device that is <u>able to receive</u> certain information (see [0008] - "the first telecommunications device only having a certain range of features (for example, it can play back or send audio files, but does not have a display suitable for showing image files)" - see also [0006]) and a device being able to limit the transmission of data to a type that it <u>wants to receive</u>. Thus, while the specification describes two different modes of operation - namely, devices that "can/are able" to receive information, and devices that "want" the information - only devices the type of information that the device "wants" (i.e., selects) to receive is claimed.

Turning to the cited references, *Yablon*, discloses a "handshake" procedure for establishing a call between a first and a second telecommunications device (FIG. 16; page 23, lines 10 to 21). According to step 1 of FIG. 16, the primary user's device informs the caller's user device about the type of information the primary users device is <u>capable</u> of receiving so that the caller's user device may only transmit the proper information the primary user's device. This configuration comports with the ITU-T Recommendation that teaches that, in order to process appropriately received multimedia signals, a capability set containing the total capability of a terminal to receive and decode various signals is made known to other terminal. Stated another way, the cited documents fail to disclose "transmitting subscriber data from the second telecommunications device to the first telecommunications device in accordance with the device information [,*which indicates a type of subscriber data that the first telecommunication device wants to receive*]."

Under the aforementioned systems of *Yablon*, none of the subscribers assigned to one of the terminals or telecommunications devices can determine which information a user wants to receive respective of other subscriber. As an example, when transmitting multimedia data (e.g., video) during a call set-up process, a subscriber will receive such data, regardless of the fact that the subscriber did not want to receive the data in the first place. Under *Yablon* and the ITU recommendation, the terminal communicates to another terminal or telecommunications device that it is able to receive video data, but nothing is provided for the management and blocking of the data. In the case of devices that are limited by processing and/or electrical power, such

unwanted reception of video data would needlessly consume processing capability and lead to unnecessary consumption of energy.

As argued previously, *Yablon* is silent regarding "transmitting subscriber data . . . in accordance with the device information," which minimizes data flow by restricting transmission to data that is wanted. In FIG. 16, Yablon teaches that the exchanging of device information (see step 2, page 23, lines 15 to 18), results in video data being transmitted by one of the telecommunications devices to the other. As a result of not being able to receive such data, a reply message is sent by the receiving telecommunications device to indicates that the information is not capable of being received. This configuration is a not effective way of exchanging device information generating a high data flow, and also teaches away from the recited claims.

The disclosure in the ITU Recommendation (5.2) is duplicative of the disclosure in Yablon (see page 23, lines 10-21). Again, the ITU document merely discloses that one device transmits receiving capability for multimedia data, but is silent regarding a configuration that allows users to manage and process the types of data (if any) it wants to receive.

As shown above, the cited references fail to disclose or suggest unique aspects of the present claims. Though one may argue that each piece is an independent element, each element is necessary and makes this inventive aspect unique. Consequently, the above-cited references fail to disclose or suggest while teaching away from the above unique aspects of the present claims. As a result, Appellants have met the burden of proof to show that the cited references fail to render obvious the present claims. Accordingly, Appellants respectfully submit that Claims 22, 30, 38 and 40 are novel, nonobvious and distinguishable from the cited references and are in condition for allowance.

III. THE PATENTABILITY OF CLAIMS 22, 30, 38 AND 40 RENDER MOOT THE REJECTIONS OF CLAIMS 23-29, 31-37 and 39

Dependent Claims 23-24, 29, 31-32, 37 and 39 were rejected under 35 U.S.C. §103(a) as being as being unpatentable over *Yablon* (WO 99/45687) in view of ITU-T Recommendation H.245, sections 5.2-5.9 (XP-002199601). Dependent claims 25, 27, 33 and 35 were rejected under 35 U.S.C. §103(a) as being as being unpatentable over *Yablon* (WO 99/45687) in view of ITU-T Recommendation H.245, sections 5.2-5.9 (XP-002199601) and further in view of

Takahashi (US Patent 5,592,546). Appellants respectfully submit that the patentability of independent Claims 22, 30, 38 and 40 as previously discussed renders moot the obviousness rejections of Claims 23-24, 29, 31-32, 37 and 39.

IV. <u>CONCLUSION</u>

For the foregoing reasons, Appellants respectfully submit that the Examiner's Answer does not remedy the deficiencies noted in Appellants' Appeal Brief with respect to the Final Office Action. Appellants respectfully submit that the Patent Office has failed to establish a *prima facie* case of obviousness under 35 U.S.C. §103(a) with respect to the rejections of Claims 22-24, 29-32 and 37-40. Accordingly, Appellants respectfully submit that the obviousness rejections are erroneous in law and in fact and should therefore be reversed by this Board.

No fee is due in connection with this Reply Brief. The Director is authorized to charge any fees which may be required, or to credit any overpayment to Deposit Account No. 02-1818. If such a withdrawal is made, please indicate the Attorney Docket No. 112740-1043 on the account statement.

Respectfully submitted,

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Dated: <u>May 29, 2007</u>